ESTTA Tracking number: **ESTTA712685**

Filing date: **12/04/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91222842
Party	Defendant The Tradition Lives On LLC
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Submission	Response to Board Order/Inquiry
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Date	12/04/2015
Attachments	Motion to Set Aside.pdf(108478 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF Trademark Application Serial No. 86/426,016
for the mark THE TRADITION LIVES ON;
Published in the Official Gazette on March 31, 2015

GREENBRIAR IA, INC.,	)	
Opposer,	)	
v.	)	**Opposition No. 91222842**
THE TRADITION LIVES ON LLC	)	
Applicant.	)	

APPLICANT'S RESPONSE TO THE BOARD'S ORDER TO SHOW CAUSE AND MOTION TO SET ASIDE NOTICE OF DEFAULT

Applicant, The Traditional Lives On, LLC, by counsel and pursuant to Section 312.02 of the Trademark Trial and Appeal Board Manual of Procedure (TMBP), hereby respectfully requests that the Board set aside the notice of default in this matter and accept for filing the Answer filed herewith.

In support of this Motion, Applicant states as follows:

1. This matter began back in April 2015, several months before the Notice of Opposition was filed. After the filing of Opposer's first request of an extension of time to oppose Applicant's registration, on April 21, 2015, Opposer's counsel sent Applicant a letter requesting the abandonment of the opposed application.

2. Upon receipt of this letter, Applicant acted swiftly to retain counsel to assist with the resolution of this matter.

3. On May 12, 2015, the undersigned called counsel for Opposer to discuss.

4. On May 13, 2015, counsel for the parties spoke about a potential settlement of this matter, and the undersigned counsel for Applicant agreed to provide additional information about Applicant's business and use of the disputed mark.

5. On June 9, 2015, counsel for the parties spoke again, and the undersigned counsel for Applicant provided the requested additional information. At that time, counsel for Opposer indicated that, in light of this information, the parties should be able to negotiate a settlement of this matter.

6. On June 22, 2015, not having heard back from counsel for Opposer, the undersigned counsel for Applicant emailed counsel for Opposer to inquire as to whether she had had an opportunity to discuss the additional information, and the terms of a potential settlement, with her client.

7. On June 23, 2015, counsel for Opposer responded, "I had emailed my client and did not get a response. I reached out to him again."

8. On June 24, 2015, counsel for Opposer followed up with some general terms of a prospective settlement, which included a limiting amendment to Applicant's description of goods and services.

9. From June 27, 2015 through July 7, 2015, the undersigned counsel for Applicant was on personal leave.

10. On July 8, 2015, upon returning to the office, the undersigned counsel for Applicant conveyed to counsel for Opposer that the general settlement terms proposed by Opposer were acceptable to Applicant. Counsel for Opposer replied that she would prepare a proposed agreement memorializing those terms.

11. On July 15, 2015, counsel for Opposer emailed the undersigned counsel for Applicant stating that she had drafted the proposed settlement agreement but was awaiting the approval of her client before transmitting it to counsel for Applicant. In that email, counsel for Opposer stated that she was going on vacation for two weeks, adding, "In order to preserve our right to oppose in the event we do not come to terms on the settlement agreement, I will be filing a Notice of Opposition." That Notice of Opposition was filed on July 17, 2015.

12. On August 5, 2015, counsel for Opposer finally transmitted a draft settlement agreement to the undersigned counsel for Applicant.

13. On August 13, 2015, the undersigned counsel for Applicant emailed counsel for Opposer to notify her that he was still discussing the terms of the proposed settlement agreement with Applicant, and requested an extension of Applicant's deadline to file an Answer in this case. Counsel for Opposer agreed the following day, and the first stipulation for extension was filed (and granted) on August 17, 2015.

14. That same day, on August 17, 2015, the undersigned counsel for Applicant emailed counsel for Opposer with some proposed revisions to the draft settlement agreement.

15. On August 18, 2015, counsel for Opposer responded as follows: "I passed your version on to my client. I suggested he sign it. If he has issues, I will change the agreement to stipulate that I will dismiss the opposition. If not and he does sign it, I will dismiss the opposition and soon as your client signs."

16. On August 28, 2015, not having heard back from counsel for Opposer, the undersigned counsel for Applicant emailed counsel for Opposer to inquire about the status of the settlement agreement and the dismissal of the Opposition. That same day, counsel for Opposer responded, "I forwarded it to my client last week and have pinged him today."

17. On September 24, 2015, again not having heard back from counsel for Opposer, the undersigned counsel for Applicant again emailed counsel for Opposer to inquire about the status of the settlement agreement, and to ask whether Opposer would consent to an additional extension of time to file an Answer.

18. That same day, counsel for Opposer responded with her consent to an additional extension of time, adding "please accept my apologies for our delay. I have asked my client for their comments several times."

19. That same day, the undersigned counsel for Applicant filed the second stipulation for extension of time in this matter, which was granted by the Board.

20. Due to an inadvertent calendaring error on the part of the staff for Applicant's counsel, the new Answer deadline was not correctly noted on the calendar of the undersigned counsel for Applicant.

21. The undersigned counsel for Applicant was on personal leave the first two weeks of November and was very busy toward the end of October (when the Answer was due) in winding up various other case obligations in advance of this leave.

22. Based on the correspondence above, the undersigned counsel was also under the impression that this matter had been resolved and that no Answer therefore needed to be filed.

23. Accordingly, the undersigned counsel neglected to double check the calendaring of the deadlines and inadvertently allowed the Answer deadline to lapse.

24. On November 30, 2015, after returning from leave, and realizing that he had again not heard back from counsel for Opposer, the undersigned counsel, the undersigned counsel for Applicant again emailed counsel for Opposer to inquire about the status of the settlement agreement.

25. Counsel for Opposer replied, "I thought you all had decided not to pursue the matter."

26. The undersigned counsel for Applicant immediately checked the case deadlines and realized that the deadlines had not been further extended after the second stipulation. The undersigned counsel for Applicant immediately requested Opposer's consent to a further extension or reopening of time.

27. The following day, counsel for Applicant responded with the somewhat familiar refrain of, "I have emailed my client. I will let you know what I hear back."

28. Not wanting to wait for any additional time to lapse, and cognizant of the previous communication lapses in this matter, the undersigned counsel for Applicant prepared the instant filing. As of the date of this filing—several days later—Opposer has still not responded to the request regarding whether or not Opposer consents to the relief requested herein.

29. Fed. R. Civ. P. 55(c) states, in pertinent part, "for good cause shown the court may set aside an entry of default." Good cause to set aside a defendant's default will be found where the defendant's delay has not been willful or in bad faith, when prejudice to the plaintiff is lacking, and where defendant has a meritorious defense. *See Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 U.S.P.Q.2d 1556 (T.T.A.B. 1991).

30. The determination of whether default judgment should be entered against a party lies within the sound discretion of the Board. *See, e.g., Identicon Corp. v. Williams*, 195 U.S.P.Q. 447, 449 (Comm'r 1977). In exercising that discretion, the Board must be mindful of the fact that it is the policy of the law to decide cases on their merits, and the Board is very reluctant to enter a default judgment for failure to file a timely answer, and tends to resolve any doubt on the

matter in favor of the defendant. *See ctrl Sys. Inc. v. Ultraphonics of N. Am. Inc.*, 52 U.S.P.Q.2d 1300 (T.T.A.B. 1999); *Thrifty Corp. v. Bomax Enters.*, 228 U.S.P.Q. 62 (T.T.A.B. 1985). In addition, where it is the attorney rather than the party itself that is responsible for the failure to properly defend an action, as is true of the instant case, courts are likely to vacate a default. *Paolo's Assocs. Ltd. P'ship v. Bodo*, 21 U.S.P.Q.2d 1899 (Comm'r 1990).

31. As illustrated above, Applicant's delay in this case was not willful or in bad faith. Indeed, Applicant has acted diligently in working to resolve this matter, and it is actually Opposer conduct—specifically, its delays of many months in responding to a proposed settlement agreement—that has contributed to the present default situation.

32. Regarding prejudice to the Oposer in setting aside the default, there is none here. In general, mere delay, in and of itself, is not enough to cause Opposer prejudice. *Paolo's Assocs. Ltd. P'ship v. Bodo*, 21 U.S.P.Q.2d 1899 (Comm'r 1990). Opposer has not asserted any grounds as to why the roughly one month delay in filing Applicant's Answer would cause it any prejudice, and any such contention would be contradicted by Opposer's own delays of several months in furthering the settlement conversation that Opposer itself initiated (by simply responding to modest changes to the draft settlement agreement that Opposer itself proposed).

33. In addition, Applicant has several meritorious defenses in this matter. In general, Applicant can establish a meritorious defense "by the submission of an answer which is not frivolous." *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 U.S.P.Q.2d 1556 (T.T.A.B. 1991). Here, Applicant has filed an Answer along with this Motion, which asserts that there is no likelihood of confusion in this case (because, as one example, there is not legal basis for Opposer's contention that Applicant's goods (t-shirts and sweatshirts) are confusingly similar

to Opposer's resort hotel services) and that Opposer appears to have abandoned its use of the disputed mark.

WHEREFORE, Applicant respectfully requests that the Notice of Default in this matter be set aside, and that the Answer filed herewith be accepted as timely filed.

Respectfully submitted,

THE TRADITION LIVES ON LLC,
By counsel,

Dated: December 4, 2015

/David Ludwig/
David Ludwig
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CERTIFICATE OF SERVICE

I hereby certify that on December 4, 2015, a true and complete copy of the foregoing was served via ESTTA and First Class mail, postage prepaid, to the following:

Mary Baril
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Richmond, VA 23219-3916

/David Ludwig/
David Ludwig